

REMARKS

Reconsideration of the above-captioned patent application is respectfully requested in view of the foregoing amendments and the following remarks.

By the forgoing amendments, new claims 6 and 7 have been added. Thus, claims 1-7 currently are pending in the above-captioned patent application and are subject to examination.

In the Office Action mailed January 15, 2004, the Examiner rejected claims 1-3 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent No. 6,594,505 B1 to Ishii. The Examiner also rejected claims 4 and 5 under 35 U.S.C. § 103(a), as being unpatentable over Ishii. Moreover, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a), as being unpatentable over Ishii. Applicant hereby traverses these rejections, as follows.

Specifically, Ishii discloses a mobile telephone system which includes "a first base station corresponding to a first mobile radio telephone system, a second base station corresponding to a second mobile radio telephone system, and a mobile radio telephone." Ishii, Column 3, Line 67; and Column 4, Lines 1-4. In operation, "as the mobile radio telephone . . . moves inside the communication area of the [first] base station . . . power is supplied to the mobile radio telephone." *Id.* at Column 4, Lines 42-47. "Then, as [a] predetermined initial data communication protocol starts a transmission from the first base station, the mobile radio telephone responds . . . and receives a first mobile radio telephone system flag from the first base station." *Id.* at Lines 50-55. "Then, the first mobile radio

telephone system flag is compared with the existing mobile radio telephone system flag, which previously [was] used [by the mobile radio telephone], to see whether the two flags coincide with each other.” *Id.* at Lines 56-59. “If the first mobile radio telephone system flag coincides with the already existing mobile radio telephone system flag, the existing mobile radio telephone communication protocol software which [was] used in the previous communication is used by the mobile radio telephone.” *Id.* at Lines 60-65. “On the other hand, if the first mobile radio telephone system flag does not coincide with the already existing mobile radio telephone system flag, the first mobile radio telephone communication protocol software used by the first base station [is] downloaded according to the initial data communication protocol.” *Id.* at Column 5, Lines 1-6. “After the downloading of the first mobile radio telephone communication protocol software is completed, the . . . system flag of the mobile radio telephone is updated, and the first mobile radio telephone system flag and the existing radio telephone system flag are arranged to coincide with each other.” *Id.* at Lines 7-14. Based on the foregoing description, it is clear that in Ishii, either the program code for the first mobile radio telephone system or the program code for the second mobile radio telephone system is stored within the mobile radio telephone, i.e., when the program code which currently is stored within the mobile radio telephone does not coincide with the program code used by the current mobile radio telephone system, the mobile radio telephone has to download the appropriate program code and replace the original program code with the downloaded program code. A similar operation occurs

when the mobile radio telephone moves inside the communication area of the second base station. See, e.g., *Id.* at Lines 31-67.

The Examiner alleges that Ishii discloses all of the elements of claims 1-3. However, in contrast to the Examiner's findings with respect to claims 1-3, Applicant submits that Ishii fails to disclose or suggest at least the combination of features of reception means for receiving a message transmitted from a base station of one of the two systems, judging means for judging whether the received message has a common format in the two systems or a different format in the two systems, a first processing means for processing the received message by performing a procedure common to the two systems when the message has a common format, and a second processing means for processing the received message by performing procedures, each procedure unique to each of the two systems, when the message has the different format, as set forth in independent claim 1. As such, in contrast to Ishii, the first processing means processes the received message when the format of the message is common to both portable telephone systems. For example, the first processing means may have stored therein the program code which is common to the two portable telephone systems. Similarly, the second processing means processes the received message when the format of the message is unique to one of the portable telephone systems. For example, the second processing means may have stored therein the program code which is unique to the first portable telephone system and the program code which is unique to the second portable telephone system. However, as described above, in Ishii's mobile telephone system, either the program code for the first

mobile radio telephone system or the program code for the second mobile radio telephone system is stored within the mobile radio telephone. For at least this reason, Applicant respectfully submits that claim 1 is allowable over the cited art and respectfully requests that the Examiner withdraw the anticipation rejection of independent claim 1.

Claims 2-5 depend from allowable independent claim 1. For at least this reason, Applicant submits that claims 2-5 are allowable and respectfully requests that the Examiner also withdraw the rejections of claims 2-5.

For similar reasons to those discussed with regard to claim 1, Applicant submits that newly added claim 6 and 7 likewise are allowable.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re

Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page . This is an insufficient showing of motivation.

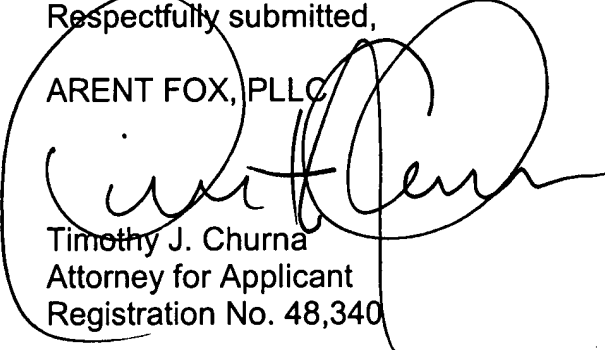
For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300.

Respectfully submitted,

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